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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/169,127	12/20/1993	HISATO SHINOHARA	0756945	2677

22204 7590 05/25/2005

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EXAMINER

PADGETT, MARIANNE L

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 05/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

08/169,127

Applicant(s)

SHINOHARA ET AL.

Examiner

Marianne L. Padgett

Art Unit

1762

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 April 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on 19 November 2004. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 61-62,64,66-67,69,71-72,74,76-77,79,81-82,84,86-87,89,91-96,101-109 & 131 (potentially).

Claim(s) objected to: _____.

Claim(s) rejected: 1-4,6-9,19,110,111 and 132-135.

Claim(s) withdrawn from consideration: 11-13,17,20-60,(63,65,68,70,73,75,78,80,83,85,90),97-100,112-130 & 136-139.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☒ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.

12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). 7/13/04

13. ☐ Other: _____.

MARIANNE PADGETT
PRIMARY EXAMINER

Continuation of 5. Applicant's reply has overcome the following rejection(s): (1) 112, 2nd problems, except in 19 (see below); (2) the 112 1st issues in claims 61-96 & 101-109 are clarified by applicants explanation with the citations in the specification & articles to Fujii et al & Mimura et al (prior art with respect to 07/097,190). Whether or not the Sera et al article is prior art with respect to when the limitation at issue were introduced, can not be determined at this time(see below); (3) and the art rejections based on Hongo et al (JP57-94482 A) as a primary reference are removed based on the convincing discussion that Hongo's language on for example p. 3 or 8 of the reference & in reference to figures, esp.4&7, is directed to scanning in the long direction of the elongated beam spot, while the examined claims scan perpendicular to Hongo's scanning direction .

Continuation of 11. does NOT place the application in condition for allowance because: no Terminal Disclaimer (TD) over copending PN 6,149,988 has been filed, hence that rejection remains & the case cannot be allowed. Also, a TD over PN 4,786,358 remains needed, as its claims 1+6, still have an obvious variation on the claimed beam spot shaping technique with claimed movement, where as a secondary reference, Hongo is still relevant for clarifying or refining beam shaping technique.

Also, note that while detailed & careful reading of Hongo et al shows that its scanning direction is essentially perpendicular to that employed by most of applicants' claims, independent claims 114 & 118 do not require movement or scanning, so these withdrawn claims are not commensurate in scope with the narrowest generic claims, so would remain withdrawn, thus needing either canceling or amending to be commensurate, for any allowance to be issued.

Claim 19 is noted to depend from 1, but "said ion blocking film" has no antecedence therein, so the 112 problem therein remains & the examiner suspects that it was intended to depend from 17.

With respect to the withdrawn claims & the effective priority date, it is noted that the oldest priority document, JP61-229,252, whose certified translation was received 3/29/95 provides support only for the generic claims 1-4, 6-9, 110-111 & 132-135 and NONE of species in the claims submitted later related to crystallization, semiconductor or other films over ion blocking layers or subspecies of Si oxides or nitrides ion blocking layers, appear to be mentioned therein, hence have a later effective date. This affects all the withdrawn claims. No certified translation of JP62-327663 (12/23/87) was found in the scanned file & while the examiner had the paper files for the related &/or parents cases until a few weeks ago, these abandon files were pull to put some paper filed by applicant & are now listed as lost by the computer, so the examiner can not order them, nor therefore determine what effective date is correct for the non-generic claims, hence what references are relevant to species that were none elected. The next species to be examined would be c)i) Si oxide ion blocking layers (# in parenthesis under non-elected claims). When was it added to the specification 12/20/93 or 12/22/88 (or JP date 12/23/87)? Citations of where in which case would be appropriate. Like information for other species a) & b) i, ii & iii, would also be required if species c)i) is not found when effective searching is enabled, in order to determine allowability with respect to unexamined species. As like information on the Si nitride ion blocking layers is not currently available to the examiner from the scanned files, it would be appropriate to complete the record by citing this information, when supplying it for non-elected species.

With respect to the crystallization species the examiner notes that Fan et al (4,309,225), in view Yamazaki et al(358) &/or Hongo et al (JP57-...) will possibly be appropriate, but it is not the next species to be examined.

